

119. (Amended) A method comprising:
creating, by using a first computer code segment, at least one list of multiple works;
presenting the works on the list including downloading, by using a second computer code segment, at least some of the works on the list from a remote source, via a communications network that is available at least intermittently, to a user station.

REMARKS

In connection with this Request for Continued Prosecution, it has been requested that Amendment B be entered along with the present Amendment C. Various of the claims have been amended hereby to more clearly set forth the present invention. Having said that, the arguments presented as to why the pending claims are allowable in Amendment B continue to be applicable. As discussed therein, Bernard et al is non-analogous art and cannot be properly combined with Contois. Additionally, even when so-combined, the deficiencies of Contois and Bernard et al do not make claims 46-119 obvious.

Attached hereto is the Declaration of one of the inventors, Mr. James D. Hempleman. In his attached Declaration, Mr. Hempleman has pointed out the factual deficiencies of Contois and Bernard et al. alone and in combination. He has also pointed out substantial differences between the functionality and purposes of Contois vs. Bernard et al which supports a conclusion that Bernard et al is non-analogous prior art and can not properly be combined with Contois. His Declaration alone is sufficient to overcome the Examiner's prima facie case of anticipation or obviousness of the rejected claims.

More particularly, as noted in Section 7 of the attached Declaration:

"Contois has no disclosure of automatically downloading from a remote source those works on a play list that are not locally available".

Further, with respect to the deficiencies of Contois as noted in Section 7.1 of the attached Declaration:

"disk drive 28 would not be considered a remote source of works relative to computer 30."

As noted in Section 7.2 of the attached Declaration:

"Contois does not disclose, teach, or, suggest the accumulation of information pertaining to those works on a play list which have been presented to a user. Information not addressed or considered by Contois includes, information pertaining to invoicing, billing information, royalty paying or royalty payments, demand analysis or popularity of selected works. In this regard, Contois is completely silent in connection with collecting such information for works on a list which have been presented to a user."

As noted in Section 7.4 of the attached Declaration:

"Contois is completely silent as to advertisements. There is no disclosure, teaching or suggestion in Contois of presenting advertisements to a user. Nor is there any disclosure or suggestion in Contois of downloading advertisements from a remote source for presentation to a user."

With respect to Bernard et al, as noted in Mr. Hempleman's declaration, Section 8.4, "Bernard et al is completely silent as to the creation and execution of play lists." In Section 8.5, "Bernard et al is completely silent as to the collection of billing information, royalty payment information or popularity information pertaining to presented works from a play list." As noted in Section 8.6 of the attached declaration, "Bernard et al does not download works on a user created play list".

As described by Mr. Hempleman with respect to various of the rejections, the claims are simply not anticipated. Mr. Hempleman has identified specific limitations in claims 39-45 (see

sections 10-11.1) which are missing from Contois. Hence, the anticipation rejection of Contois relative to those claims is improper and should be withdrawn.

Further, in the attached declaration, Sections 11-14, Mr. Hempleman identifies specific limitations from various pending claims which are not present in either Contois or Bernard et al and are not made obvious by Contois read in view of Bernard et al. There is no articulated suggestion or motivation to modify that combination to make obvious pending claims 67-116 except the disclosure of the present application. These rejections are based on hind-sight reconstruction and not based on any suggestion or motivation reasonably presented by either Contois or Bernard alone or read in combination. Hence, as set forth in Amendment B and further amplified upon by the attached by the attached Declaration, pending claims 67-116 are not obvious. The rejections of those claims should be withdrawn.

More particularly, claim 67 includes the following limitations that are not made obvious by Contois in view of Bernard et al:

"first software executable at least in part at a user station for creating at least one list of multiple works; and second software executable at least in part at the user station for downloading at least some of the works on the list, via a communication network available at least intermittently, from a remote source, to the user's station."

Contois does not address the claimed solution to missing works on an executable play list. Contois is completely silent in this regard. Bernard et al is merely a product purchasing system and do not address creating play lists. Nor, does Bernard et al address missing works as claimed, namely:

"second software executable at least in part at the user station for downloading at least some of the works on the list, via communication's network available at least intermittently, from a remote source, to the user station."

Bernard et al teaches the purchasing of goods from a remote source and providing provisions for the delivery of such goods to the purchaser. Bernard et al are not analogous subject matter and adds nothing to the teaching of Contois in connection with executable play lists. The Examiner has not identified any specific suggestion, motivation, or teaching in either of Contois or Bernard et al alone or in combination which suggests not only making the combination proposed by the Examiner but modifying same so as to make the above-quoted limitations of claim 67 obvious. Those prior art documents simply do not address the problems solved by the system of claim 67. Hence, for at least the above reasons, claim 67 is allowable over Contois in view of Bernard et al. Similar comments apply to the allowability of claims 68-91, all of which depend directly or indirectly from claim 67. For at least the above reasons, the rejections of those claims should also be reversed.

By way of further example, claim 72 adds to claim 67 the following unmet limitation:

"collection software to collect information used for royalty-related payments that result from presenting works on the list, wherein the software is located, at least in part, at one of the user station or the remote source."

Neither Contois nor Bernard et al alone or in combination address collection of information as claimed. Contois does not keep track of such information. Bernard et al do not address play lists at all. Only the present application addresses royalty related payments as claimed. There is no suggestion in either Contois or Bernard et al alone or in combination to modify any combination thereof to make obvious the added limitation of claim 72.

Neither Contois nor Bernard et al alone or in combination address downloading works on a play list from a remote source and collecting information pertaining to popularity of the works as in claim 73. Contois simply does not address popularity issues. Bernard et al's product purchasing system does not address collecting popularity information of works on play lists as claimed. Rather, it is oriented toward facilitating the purchase and delivery of product. There is simply no suggestion in Contois or Bernard et al alone or in combination to modify same to make obvious the added limitation of claim 73.

By way of further example, claim 77 adds to claim 67 the following limitation also not made obvious by Contois in view of Bernard et al:

"control software enabling a local user to select at least some works in a remote inventory based on user specified selected characteristics of the works and view a screen containing at least some of the selected works, wherein the control software is located, at least in part, at one of the user station or the remote source."

The Examiner has failed to identify any specific suggestion, teaching or motivation in either of the prior art documents relied on as to why the limitations of claim 77, including the above, would be obvious. As noted above, Fig. 1 discloses a locally based system in Contois which enables a user to select works to be output on a local output device such as a player piano. Contois has no teaching which would make the limitations of claim 77 obvious. The teaching of Bernard et al does not make up for the deficiencies of Contois in that Bernard et al teaches the purchase of products from a remote supplier and the delivery of those products to a purchaser. Those products are not analogous to the selected works of claim 77. Merely pointing to Bernard et al does not provide the necessary suggestion, motivation or teaching to make the combination with Contois. Nor, does that combination teach the modifications necessary thereto to make the limitations of claim 77, including the above, obvious.

By way of further example, claim 78 adds to claim 67 the following limitation not made obvious by Contois in view of Bernard et al:

"software for controlling a media writing device, coupled to the user station, whereby selected works on the list can be written to a removable medium after the works are downloaded." (claim 78)

Neither Contois nor Bernard et al make obvious enabling a user to write downloaded works to a removable medium as in claim 78. Contois addresses only locally available works. Bernard et al teach delivery of purchased product via a delivery service or to a purchaser in a store.

Further, claim 85 adds the following limitation not made obvious by Contois in view of Bernard et al:

"software to collect information used for billing-related purposes based on presented advertisements, wherein the software is located, at least in part, at one of the user station or the remote source." (claim 85)

Contois is completely silent relative to advertisements. Bernard et al is directed to facilitating the purpose of goods from a remote source and is also completely silent relative to the subject matter of the limitation added by claim 85 quoted above. Once again, no specific suggestion, motivation or teaching has been identified as to why the combination of Contois in view of Bernard et al, even if properly makeable, would make obvious the limitations of claim 85.

Similar comments apply to the rejections of claims 92-116. For example, claim 92 defines a method which requires:

"creating at least one list of multiple works; presenting the works on the list to a user, including downloading at least some of the works on the list from a remote source, via a communications network that is available at least intermittently, at a user station."

Once again, no specific suggestion, motivation, or teaching has been identified whereby the combination of Contois in view of Bernard et al, even if properly makeable, makes obvious the limitations of claim 92. Contois, see Fig. 1 thereof, enables the user to present works from a local source. Bernard et al simply does not address enabling a user to build or create executable play lists of works. Bernard et al is directed to facilitating purchasing of products from a remote

source and physical delivery of those products by shipping or directly to a customer in a store. The Examiner has not identified where Contois in view of Bernard et al makes obvious "downloading at least some of the works on the list from a remote source, via a communications network" as claimed.

Claim 93 adds to claim 92 the following limitation that made obvious by the Examiner combination:

"wherein at some of the works are presented at the user station at substantially the same time they are downloaded." (claim 93)

Once again, no specific suggestion, teaching, or motivation has been provided in the rejections which would make the above-quoted limitation of claim 93, in combination, obvious.

By way of further example, claim 108 adds to claim 93 the following unmet limitation:

"presenting at the user station additional works comprising advertisements at substantially the same time that works on the list are presented at the user station."
(claim 108)

Neither Contois nor Bernard et al address the subject matter of method claim 108. Contois is completely silent relative to advertising. Bernard et al, a product purchasing system, provides no suggestion, teaching or motivation to modify Contois in accordance with the limitations of claim 108.

For the above reasons, along with the reasons set forth in the Hempleman Declaration, all of claims 92-116 are allowable over Contois in view of Bernard et al. Those rejections should be withdrawn.

In rejecting claims 117-119, the Examiner has stated that:

"These claims are rejected on grounds corresponding to the arguments given above for rejected claims 40-46 and are similarly rejected."

Each of those rejected claims includes one or more limitations which are clearly not made obvious by Contois read in view of Bernard et al. In this regard, claim 117 requires:

"a fourth plurality of pre-stored instructions responsive to presented works for at least one of collecting royalty payment information, establishing a credit, collecting information for billing, accumulating popularity information or generating selected reports " (claim 117).

The Examiner has failed to identify a specific motivation, teaching or suggestion in connection with the combination of Contois in view of Bernard et al which teach making the required modifications to that combination so as to make the above-noted limitation from claim 117 obvious. Contois discloses and teaches presenting locally available works, see Fig. 1 thereof at no charge. Bernard et al teaches the purchase of products from a remote source and physical delivery of same to a purchaser. Nothing about Bernard et al makes up for the deficiencies of Contois in this regard so as to make obvious the above quoted limitation. Similar comments apply to the rejections for claims 118 and 119.

Remaining rejected claims that have not been explicitly addressed are allowable for at least the above reasons as well as reasons articulate in previously filed Amendment B.

For all of the above reasons, the pending claims are allowable. Allowance of the application is respectfully requested.

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A marked copy of the amended claims is attached.

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MARKED VERSION OF THE CLAIMS

40. (Amended) A system for creating a list of selected titles comprising:
a source of works which may include, at least in part, an audio component;
a visual output device;
circuitry, coupled to the source and the output device, for building an inventory list of works and for creating a displayable list of works of at least some of the inventory on the output device wherein the circuitry includes instructions for selecting works [in] to be included in the displayable list in accordance with a selected characteristic, and, for executing a plurality of such selected works.

41. (Amended) A system as in claim 40 which includes executable instructions for selecting works to be included in the displayable list in accordance with one of a selected audio characteristic, a selected video characteristic, or a selected popularity indicium.

48. (Amended) A system comprising:
executable instructions for accessing at least one source of works;
executable instructions for creating at least one play list; and
executable instructions for [executing the] presenting works on the at least one play list and for maintaining information pertaining to royalty payments for at least some of the presented works.

49. (Amended) A system as in claim 48 which includes additional instructions for maintaining information as to popularity of various presented works.

68. (Amended) A system as in claim 67 wherein at least some of the works on the list are presented at the user station at substantially the same time they are downloaded.

69. (Amended) A system as in claim 67 wherein at least some of the works on the list are downloaded each time they are presented on the user station.

70. (Amended) A system as in claim 67 wherein at least one work on the list is downloaded after determining that the work is not available at the user station.

72. (Amended) A system as in claim 67 which includes collection software to collect information used for royalty-related payments that result from presenting works on the list, wherein the software is located, at least in part, at one of the user station or [and] the remote source.

73. (Amended) A system as in claim 67 which includes collection software to collect information used to keep track of the popularity of at least some of the presented works, wherein the software is located, at least in part, at one of the user station or [and] the remote source.

75. (Amended) A system as in claim 74 which includes control software enabling a local user to select works from the remote inventory for insertion in the list, wherein the software is located, at least in part, at one of the user station or [and] the remote source.

76. (Amended) A system as in claim 67 which includes control software enabling a local user to sort at least some works in a remote inventory based on user specified selected characteristics of the works and view a screen containing at least some of the sorted works, wherein the control software is located, at least in part, at one of the user station or the remote source.

77. (Amended) A system as in claim 67 which includes control software enabling a local user to select at least some works in a remote inventory based on user specified selected characteristics of the works and view a screen containing at least some of the selected works, wherein the control software is located, at least in part, at one of the user station or the remote source.

78. (Amended) A system as in claim 67 which includes software for controlling a media writing device, coupled to the user station, whereby selected works on the list can be written to a removable medium after the works are downloaded.

79. (Amended) A system as in claim 67 which includes software for controlling a media writing device, coupled to the user station, whereby selected works on the list can be written to a removable medium at substantially the same time the works are downloaded.

84. (Amended) A system as in claim 67 which includes software to collect information used for billing-related purposes based on presented works on the list, wherein the software is located, at least in part, at one of the user station or the remote source.

90. (Amended) A system as in claim 67 wherein at least some of the downloaded works on the list comprise video.

91. (Amended) A system as in claim 67 wherein at least some of the downloaded works on the list are selected from a class which includes audio works, moving video works, still video works, and other predetermined sensory works.

92. (Amended) A method comprising:
creating at least one list of multiple works;
presenting the works on the list to a user, including downloading at least some of the works on the list from a remote source, via a communications network that is available at least intermittently, [to] at a user station.

97. (Amended) A method as in claim 92 which includes collecting information pertaining to presented works to be used for royalty-related payments.

98. (Amended) A method as in claim 92 which includes collecting information used to keep track of the popularity of at least some of the works presented to the user.

101. (Amended) A method as in claim 92 which includes enabling a local user to sort at least some works in a remote inventory based on user specified [selected] characteristics of the works and to view a screen containing at least some of the sorted works.

102. (Amended) A method as in claim 92 which includes enabling a local user to select at least some works in a remote inventory based on user specified [selected] characteristics of the works and to view a screen containing at least some of the selected works.

104. (Amended) A method as in claim 92 which includes controlling a media writing device, coupled to the user station, whereby selected works on the list can be written to a removable medium at substantially the same time the works are downloaded.

109. (Amended) A method as in claim 92 including collecting information used for billing-related purposes based on presented works.

112. (Amended) A method as in claim 92 including monitoring one of billing or credit based on presented works.

117. (Amended) A system comprising:

a first plurality of pre-stored instructions enabling a user to identify a selected plurality of works;

a second plurality of pre-stored instructions for presenting members of the plurality of works at a presenting station;

a third plurality of pre-stored instructions for establishing at least intermittently, a communications link between a source of works and the presenting station with at least some of the works provided at the presenting station, via the link, each time they are presented; and

a fourth plurality of pre-stored instructions responsive to presented works for at least one of collecting royalty payment information, establishing a credit, collecting information for billing, accumulating popularity information or generating selected reports with at least a portion of the first plurality of instructions located at one of the presenting station and the source.

118. (Amended) An apparatus comprising:

a first plurality of computer instructions executable at least in part at a user station for creating at least one list of multiple works; and

a second plurality of computer instructions executable at least in part at the user station for downloading at least some of the works on the list for presentation at the user station, via communications network that is available at least intermittently, from a remote source, to the user station.

119. (Amended) A method comprising:

creating, by using a first computer code segment, at least one list of multiple works;

presenting the works on the list including downloading, by using a second computer code segment, at least some of the works on the list from a remote source, via a communications network that is available at least intermittently, to a user station.